

### **REMARKS**

Reconsideration and withdrawal of the rejections set forth in the Office Action dated November 17, 2009, is respectfully requested in view of this amendment. By this amendment, claims 2, 6, 8 and 9 have been cancelled, claims 1, 3, 4, 7, 10, 11, 14, 18, 19 and 22 have been amended, and new claims 26 and 27 have been inserted. Claims 1, 3-5, 7, 10-24, 26 and 27 are pending in this application. Claims 12-24 have been withdrawn, and so claims 1, 3-5, 7, 10, 11, 26 and 27 are presented for examination.

The cancellation of claims 2, 6, 8 and 9 and the limitations as applied to the remaining independent claims is made without prejudice to later prosecution of the subject matter of these claims in this application or a subsequent continuation application.

Claim 1 was amended by incorporating features of claims 2, 6 and 9 as originally filed, and to describe features related to securing at least one electrode to a part or model, the magnetic connecting means comprising two parts which interact with one another, a connection of one of the parts to the current/voltage source and the connection of the other parts to an electrode or part of an electrode. The description, originally in claim 6 and now applied to claim 1, of "assigned to" has been changed to refer to a connection and to describe the connection. Claims 7 was likewise amended to change "assigned to" to refer to a connection and to describe the connection. New claims 26 and 27 correspond to claims 5 and 11, respectively but depend from claim 4.

It is respectfully submitted that the above amendments introduce no new matter within the meaning of 35 U.S.C. §132.

In the outstanding Office Action, the Examiner objected to claims 6, 7, and 9 due to informalities. Claims 1-11 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Claims 1, 2, and 4-11 are rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 3,575,832 to Johnson (hereinafter *Johnson*); and claim 3 is rejected under 35 U.S.C. §103(a) as obvious over *Johnson*. These objections and rejections, as applied to the revised claims, are respectfully traversed.

### **Claim Objections**

The Examiner objected to claims 6, 7 and 9 as presenting the phrase, "assigned to". By this Amendment, the terminology has been cancelled and the claims have been amended to describe "connections" of the parts.

Accordingly, the objections to the claims are believed to be overcome.

### **Rejections Under 35 U.S.C. §112**

The Examiner rejected claims 1-11 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Specifically, the reference to "in particular" was deemed unclear.

### **Response**

By this Amendment, the terminology, "in particular" has been cancelled. This is believed to avoid the alternative phraseology. Hence, Applicant submits that the rejections of Claims 1-11 under 35 U.S.C. §112 are overcome.

It is therefore respectfully submitted that the rejection under 35 USC §112 should be withdrawn.

### **Rejections under 35 USC §102**

Claims 1-10 were rejected under 35 USC §102(b) as anticipated by *Johnson*. *Johnson* is cited as teaching an apparatus which is capable of functioning for the electrodeposition of shaped dental parts in which a magnetic connecting means for producing the electrical contact for the electrodeposition is allegedly positioned between at least one electrode and the current/voltage

source, with an electromagnet acting as a magnetic connecting means through which electrical contact is made to the workpiece. The Office Action points to column 1 lines 49-58 which states in part:

"... For electrodeposition, electrical connection between workpiece and external coating circuit is made through the electromagnetic contact assembly."

### **Response**

This rejection is traversed as follows. For a reference to anticipate an invention, all of the elements of that invention must be present in the reference. The test for anticipation under section 102 is whether each and every element as set forth in the claim is found, either expressly or inherently, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131. The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP §2131.

Applicants' claim 1 sets forth:

"An apparatus for electrodeposition of shaped dental parts ...[which] are electrodeposited by securing at least one electrode to a part or model to be coated by electrodeposition ... magnetic connecting means for producing the electrical contact for the electrodeposition between at least one electrode and the current/voltage source ... one part ... of the magnetic connecting means connected to the current/voltage source and one part ... connected to an electrode or part of an electrode."

*Johnson* fails to teach or suggest the feature of the magnetic connecting means connected to the current/voltage source and fails to teach or suggest the feature of the magnetic connecting means connected between the electrode and the current/voltage source. Therefore, Applicants submit that the Examiner has failed to show where each and every feature of the presently claimed subject matter is purportedly disclosed, taught or suggested in the cited prior art, which is the test for anticipation under 35 U.S.C. §102.

To the contrary, the magnetic force according to *Johnson* is applied between the electrode and the object to be painted (e.g., spring, bolt, screw). There is no magnetic force between the electrode (represented e.g., by loading assembly 17) and the current/voltage source of *Johnson*.

Applicants respectfully submit that the *Johnson* reference does not teach or suggest all the features as recited in claims 10-29 of the present application. It is therefore respectfully submitted that the rejection under 35 U.S.C. §102 should be withdrawn.

### **Applicability of 35 USC §103**

It is noted that the features described above in connection with the *Johnson* reference specifically contradict the present subject matter as claimed. Therefore it would be unobvious to modify *Johnson* to meet the presently claimed features with respect to, "magnetic connecting means for producing the electrical contact for the electrodeposition between at least one electrode and the current/voltage source."

Claim 1, as now presented, sets forth the electrodeposition of shaped dental parts by securing at least one electrode to a part or model which is then coated by electrodeposition. This is described in detail in the specification, *inter alia*, at paragraphs [0038] and [0041] (as published in U.S. Published Application No. 2006-0131162). "Electrodeposition" as set forth in the specification and claims is electrodeposition "of metallic layers" resulting in stable (three-dimensional) bodies as explained in paragraph [0002] of the description. This coincides with Applicants' description as set forth in claim 1, but is inconsistent with *Johnson*.

As described by Applicants in paragraph [0007] the part/model on which the shaped dental part is to be electrodeposited, has to be connected carefully, to the electrode. It would not be possible to "pick up" such parts/models as it is done with the objects to be painted according to the *Johnson* citation. Such dental models are sensitive and the dental technician had a lot of work to prepare such models. The technician would never consider subjecting the dental models to a method as described by *Johnson*, which is used for basic objects like coils, springs, bolts and screws.

It is respectfully pointed out that *Johnson* will not be considered by a person skilled in the art of the dental field. Accordingly, the *Johnson* citation could not give any hint into the direction of the apparatus now claimed in claim 1. To place this different technology in context, Applicants note that citation was already published in 1971 and therefore more than 30 years elapsed before Applicants' priority date. As outlined in paragraph [0003] of Applicants' specification, galvanofforming in the dental technology also dates back to the 1960's, but without the use of the technique described in claim 1. Therefore, the *Johnson* reference was not considered in such field for over thirty years.

### **Rejection of Claim 3 Under 35 U.S.C. §103**

The Examiner rejected claim 3 under 35 U.S.C. §103(a) in view of *Johnson*. This rejection, as applied to amended claim 3, is respectfully traversed.

### **Response**

This rejection is traversed as follows. To show obviousness under §103, it is necessary to show an incentive to benefit from the change. *KSR International Co. v. Teleflex Inc. et al.*, 127 S.Ct. 1727, 82 USPQ2d 1385 (2007).

"The proper question to have asked was whether a pedal designer of ordinary skill, facing the wide range of needs created by developments in the field of endeavor, would have seen a benefit to upgrading Asano with a sensor. In automotive design, as in many other fields, the interaction of multiple components means that changing one component often requires the others to be modified as well." (*id* at 127 S.Ct. 1744)

A demonstration of obviousness under §103 requires that the combination represent a design step well within the grasp of a person of ordinary skill in the relevant art. *id*.

"KSR provided convincing evidence that mounting a modular sensor on a fixed pivot point of the Asano pedal was a design step well within the grasp of a person of ordinary skill in the relevant art. (*id* at 127 S.Ct. 1746)

The standard for anticipation under 35 USC §102 and obviousness under 35 USC §103(a) following *KSR* is detailed in *Forest Labs v. Ivax Pharmaceuticals*, 501 F.3d 1263; 84 USPQ 2d 1099; 41 A.L.R. Fed. 2d 697 (2007). In *Forest Labs*, the court determined that a reference mentioned a particular chemical component, but did not explain how to obtain it and therefore deemed that, "A reference that is not enabling is not anticipating." The court then deemed the product was therefore unobvious over that reference.

*Johnson* is acknowledged as not describing electrodeposition wherein the magnetic connecting means comprises two magnets. Instead, the rejection under 35 USC §103(a) alleges that it would have been obvious to provide a second contact point or a second electromagnetic, with reference to duplication of parts. This stipulation fails to meet the *KSR* test because the use of two magnets wherein in combination with, "one part ... of the magnetic connecting means connected to the current/voltage source and one part ... of the magnetic connecting means connected to an electrode or part of an electrode," is not a mere design step (not "a design step well within the grasp of a person of ordinary skill in the relevant art"). In this regard, *Johnson* specifies that the work is held by the magnet of the loading assembly. For example:

"Bolt 35 is attracted to and held by the magnet of loading assembly 19 which is then raised to its upper position." (*Johnson* at column 3, lines 19-25.)

Therefore *Johnson* fails to suggest Applicants' arrangement of positioning the magnet between the electrical source and the electrode. This is more than a superficial difference; it is a basic function of the *Johnson* operability.

It is therefore respectfully submitted that the rejection under 35 U.S.C. §103(a) should be withdrawn.

Applicant respectfully request that the Examiner withdraw the rejections and that the case be passed to issuance.

### **INFORMATION DISCLOSURE**

In the outstanding Office Action, the Examiner pointed out that the content of French Brevet Nr. 1,226,638 was not accompanied by a concise explanation of its relevance.

This document describes the maintenance of the conducting parts intended to receive coatings in electrolytic baths or to undergo similar treatments, and the support of the parts during electrolytic processes. The support also ensures the necessary electrical contact so that these parts receive the electric currents intensities and polarities suitable for electrolytic treatments. The magnetic fields can be established by permanent magnets or electromagnets.

In particular Figs. 3 and 4 describe electrical contact established from the attraction by the magnetic field without additional contact devices. In Fig. 3, the assembly includes a core 10 against which the part 1 is held by magnetic attraction. A reduced air-gap 15 is used.

In Fig. 4, an intermediate part 16 made out of ferromagnetic metal is interposed between a magnetic or electromagnetic assembly 17 and part 1. A hollow portion engages the surface of the part 1.

Accordingly, entry of Brevet Nr. 1,226,638 as a reference considered during examination is earnestly solicited.

### **CONCLUSION**

In light of the foregoing, Applicants submit that the application is in condition for allowance. If the Examiner believes the application is not in condition for allowance, Applicants respectfully request that the Examiner call the undersigned.

Respectfully submitted,  
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May 13, 2010

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